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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,077	10/06/2000	Paul Bilibin	PSTM0020/MRK/STM	3148
29524	7590	11/29/2004	EXAMINER	
KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER

3629

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/685,077

Applicant(s)

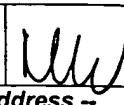
BILIBIN ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed September 25, 2004.

### ***Specification***

2. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8-13, 15-20, 22-27, 29-34, 36-41, and 43-57 are rejected under 35

U.S.C. 102(b) as being anticipated by Nicholls et al. (5,485,369).

5. With respect to Claims 1-5, 8-12, 15-19, 22-26, 29-33, 36-40, and 43-57: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to

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(column 4, lines 8-24, and columns 15-27) collect parcel specifications, such as weight and dimensions (Figures 4A and 4B), and determines a dimensional weight (Columns 21 and 22, line 65) and uses the weight to calculate rates for the shipment (column 5, lines 34-40, columns 25 and 26, line 39). The examiner considers this to be a dimensional weight calculation rule.

Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

6. With respect to Claims 6, 13, 20, 27, 34, and 41: See Column 8, lines 43-55.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 7, 14, 21, 28, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al. in view of Kara et al. (6,233,568).

10. Nicholls, as disclosed above for claims 3, 10, 17, 24, 31 and 38, discloses the use of calculating rates for multiple carriers, but discloses the automatic selection of the carrier, and fails to disclose displaying all of the rates to the user. Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. See Kara, column 22

### ***Response to Arguments***

11. With respect to the Objection to the specification due to the use of Trademarks: The applicant has stated the specification was amended to correct the problem, however the specific terms which were listed in the objection were not amended, and therefore the objection still stands.

12. With respect to Applicant's discussion in terms of the difference between "dimensional weight", "billable weight" and "ratable weight": As stated by the applicant these three weights are set by the carrier according to the carrier rules, therefore they are uncontrolled variables. The

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method and system that are claimed are directed to a method of displaying calculated rates, not for setting the carrier rules, therefore considered a variable that is controlled by the carrier, not the invention itself. Therefore, giving then broadest reasonable interpretation, according to the specification, these three weights are the same or equal. For examination purposes they have been treated with that interpretation.

13. Applicant's arguments filed 9/25/04 have been fully considered but they are not persuasive.

14. With respect to Applicant's argument that Nicholls is not directed to multiple users and a plurality of carriers: Nicholls discloses a system that is used on a user system, the claim states "each respective user computer", therefore there is no difference in the fact that both Nicholls and the claimed invention, only one user uses one computer at a time. Nicholls discloses that there are multiple clients, which use this system and are connected over a network (See Figure 3A), and discloses the system calculates rates for multiple carriers (See Figure 2). Therefore Nicholls does disclose the system being used for a plurality of users and a plurality of carriers.

15. With respect to Applicant's argument that Nicholls does not disclose generating an online comparison display of carrier-specific shipping rates: Where as this is true, this feature is taught by Kara, and the displaying of the rates is not taught till Claim 6.

16. With respect to Applicant's argument that Nicholls does not disclose the use of dimensional weight, billable weight and ratable weight: As disclosed above these three terms all depend on the carrier rules, and given the broadest reasonable interpretation these terms are considered to be equal. Nicholls discloses using dimensional weight, and discloses carrier-specific rate servers, the carriers would have to use their own rules to calculate their own rates,

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therefore it is the examiner's position that Nicholls discloses the use of dimensional weight, billable weight and ratable weight.

17. With respect to Applicant's arguments that Nicholls and Kara do not disclose the use of weight limitations and displaying the rates after the comparison of the weight to the weight limitations was done: Nicholls discloses that weight is a factor in determining the calculated rate (See Figure 4D), and Kara discloses that each class has set weight limitations (Column 2, lines 62-67). Therefore if these things are automatically factored into the calculation of rates, then it is obvious that the rates are displayed after the comparison is done. If a carrier cannot ship something due to weight, then why would a rate be calculated? The examiner considers Nicholls and Kara to disclose this feature and all claimed limitations, therefore the rejections stand as stated above.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

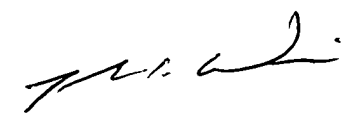
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579.

The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jamisue Webb

  
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